

REMARKS

The preceding amendments and the following remarks are submitted as a full and complete response to the non-final Office Action issued on August 7, 2008. Claims 1, 9, 39 and 48 have been amended. Support for the amendments may be found, *inter alia*, at ¶¶ 0014, 0018, 0019 and 0122-0127 and Figs. 22 and 23 of the originally filed application. No new matter is added.

The Abstract has been amended to overcome the Examiner's objections. Non-elected claims 6-8, 13-38, 40-47, 49-58, 60, 61 and 64-75 are canceled. Claim 63 is amended. No new matter is added. Therefore, claims 1-5, 9-12, 39, 48, 62, 63 and 76 are pending for reconsideration.

An objection was made to claim 63 because of an informality. Applicants have amended claim 63 as per the Office's kind suggestion. Accordingly, Applicants submit that this objection is moot and request that it be withdrawn.

Claims 1-3, 9 and 76 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 13 of U.S. Patent No. 6,876,472. Applicants respectfully traverse. Applicants have amended claim 1, from which claims 2, 3 and 76 depend, to recite the feature that "at least one subarea is embossed with an embossing die." This claim feature is patentably distinct from the claims of U.S. Patent No. 6,876,472. Claim 9 has been similarly amended.

Accordingly, Applicants submit that this rejection has been overcome, and request that it be withdrawn.

Claims 1-3, 9, 39, 48 and 76 were rejected under 35 U.S.C. § 102(b) as being anticipated by published U.S. Patent Application No. 2002/0044313 to Menz et al., now U.S. Patent 6,876,472 ("Menz"). Applicants respectfully traverse as Menz fails to disclose each and every element of the claimed invention.

Independent claim 1, from which claims 2, 3, 4 and 76 depend, recites a security element, which has at least one area with a diffraction structure embossed with an embossing die, which under specific viewing conditions reconstructs a diffractive image, wherein the area has subareas, which do not take part in the reconstruction of the diffractive image, and which represent a recognizable information, characterized in that the information represented by the subareas is recognizable substantially only under the

specific viewing conditions and at least one subarea is embossed with an embossing die.

Menz requires that at least one subarea is subsequently modified by a laser or printing against participating in the image reconstruction. Menz, claim 1. In contrast, as is apparent from Fig. 23 and the corresponding description in the present application, the diffraction structure 119 of the embossing mold 118 of the present invention can be destroyed in the area 120 for example by means of a laser, such that during the embossing process the relief structure as well as the destroyed areas 120 are transferred into the surface of the security element (cf. ¶ 0127 of the present application). Moreover, the surface of the embossing die in the area believed to correspond to the inventive subarea of the security element can also experience only a modification. Hence, the amended claims essentially relate to the fact that the at least one subarea is not generated subsequently by impact of a laser or by overprinting as suggested by Menz, but in that the embossing mold is accordingly modified in the respective subarea. The at least one subarea according to the amended claims can, thus, not exhibit any individual information to be applied subsequently but only an information predetermined by the respective embossing die, which is identical for all embossed holograms. Thus, Menz fails to disclose each and every feature of claim 1.

Claims 9, 39 and 48 have been amended similarly to claim 1, and thus are allowable over Menz for at least the reasons above.

Thus, Menz fails to disclose each and every element of claims 1, 9, 39 and 48 upon which claims 2, 3 and 76 depend. Applicants submit that this rejection has been overcome, and request allowance of claims 1-3, 9, 39 and 76.

Claims 4-5, 10-12, 59 and 62-63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Menz in view of published U.S. Patent Application No. 2002/0191234 to Ishimoto et al. ("Ishimoto"). Applicants respectfully traverse the rejection, on the basis that the cited prior art, taken singly or in combination, fails to disclose or suggest each and every feature of the claimed invention. Ishimoto fails to cure the deficiencies of Menz, because Ishimoto is merely directed to a laminate which prevents reuse of holograms. Ishimoto, abstract.

Thus, the combination of Ishimoto and Menz fail to disclose or suggest each and every element of claims 1 and 9, from which claims 4-5, 10-12, 59 and 62-63 depend. Applicants submit that this rejection has been overcome, and request allowance of claims 4-5, 10-12, 59 and 62-63.

All objections and rejections having been addressed, Applicants respectfully request allowance of this application.

In the event that this paper is not timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Deposit Account No. 02-2135.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

Respectfully submitted,

Date: November 7, 2008

By: /Brian A. Tollefson/
Attorney for the Applicants
Brian A. Tollefson
Reg. No. 46,338
David B. Orange
Reg. No. 55,513
ROTHWELL, FIGG, ERNST & MANBECK
1425 K Street, N.W.
Suite 800
Washington, D.C. 20005
(202) 783-6040

#1547589_1